



AR
Xerox Docket No.D/97427/2B4

PATENT APPLICATION

PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

James D. THORNTON et al.

On Appeal from Group: 2134

Application No.: 08/976,579

Examiner: Christopher J. Brown

Filed: November 24, 1997

Docket No.: 034191

For: PAPER DOCUMENT SATCHELS

RECEIVED

MAY 27 2004

Technology Center 2100

APPEAL BRIEF TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

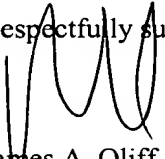
Sir:

Attached hereto are three (3) copies of our Brief on Appeal in the above-identified application.

The Commissioner is hereby authorized to charge Deposit Account No. 24-0037 in the amount of Three Hundred Thirty Dollars (\$330.00) in payment of the Brief fee under 37 C.F.R. 1.17(f). In the event of any underpayment or overpayment, please debit or credit our Deposit Account No. 24-0037 as needed in order to effect proper filing of this Brief.

For the convenience of the Finance Division, two additional copies of this transmittal letter are attached.

Respectfully submitted,


James A. Oliff
Registration No. 27,075

Richard S. Elias
Registration No. 48,806

JAO:RSE/dap

Date: May 24, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

**DEPOSIT ACCOUNT USE
AUTHORIZATION**
Please grant any extension
necessary for entry;
Charge any fee due to our
Deposit Account No. 24-0037



Xerox Docket No.D/97427

PATENT APPLICATION

PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

James D. THORNTON et al.

On Appeal from Group: 2134

Application No.: 08/976,579

Examiner: Christopher J. Brown

Filed: November 24, 1997

Docket No.: 034191

For: PAPER DOCUMENT SATCHELS

RECEIVED

MAY 27 2004

Technology Center 2100

APPEAL BRIEF TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

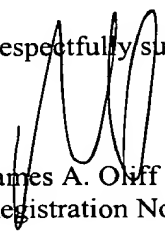
Sir:

Attached hereto are three (3) copies of our Brief on Appeal in the above-identified application.

The Commissioner is hereby authorized to charge Deposit Account No. 24-0037 in the amount of Three Hundred Thirty Dollars (\$330.00) in payment of the Brief fee under 37 C.F.R. 1.17(f). In the event of any underpayment or overpayment, please debit or credit our Deposit Account No. 24-0037 as needed in order to effect proper filing of this Brief.

For the convenience of the Finance Division, two additional copies of this transmittal letter are attached.

Respectfully submitted,


James A. Oliff
Registration No. 27,075

Richard S. Elias
Registration No. 48,806

JAO:RSE/dap

Date: May 24, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 24-0037</p>



XEROX DOCKET NO. D/97427

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of:

James D. THORNTON et al.

Application No.: 08/976,579

Examiner: C. Brown

Filed: November 24, 1997

Docket No.: JAO 34191

For: PAPER DOCUMENT SATCHELS

RECEIVED

MAY 27 2004

Technology Center 2100

BRIEF ON APPEAL

05/25/2004 EAREGAY1 00000088 240037 08976579

01 FC:1402 330.00 DA

Appeal from Group 3700

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400
Attorneys for Appellants

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
A. Real Party in Interest.....	1
B. Statement of Related Appeals and Interferences.....	1
C. Status of Claims	1
D. Status of Amendments.....	1
II. SUMMARY OF THE INVENTION AND APPLIED REFERENCES	2
A. Problems Addressed by the Invention	2
B. General	2
C. Description of the Invention.....	2
D. Advantages Over the Prior Art.....	4
III. THE ISSUES	4
IV. GROUPING OF CLAIMS	5
V. ARGUMENT.....	5
A. Summary of Relevant Law.....	5
1. 35 USC §102	5
2. 35 USC §103(a)	5
B. The 35 U.S.C §102(b) Rejection of Claims 29-35 Lacks Factual Support	8
C. The 35 U.S.C §103(a) Rejection of Claims 36, 37 and 39-45 Lacks Factual Support.....	13
VI. CONCLUSION	16
APPENDIX.....	A-1

I. INTRODUCTION

This is an Appeal from a final Office Action mailed January 15, 2004, finally rejecting claims 29-37 and 39-45 of the above-identified patent application.

A. Real Party in Interest

The real party in interest in this Appeal in the present application is Xerox Corporation, by way of an Assignment filed on November 24, 1997, and recorded at Reel 8835/Frames 0653-0654.

B. Statement of Related Appeals and Interferences

There are presently no appeals or interferences, known to Appellants, Appellants' representative or the Assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

C. Status of Claims

Claims 29-37 and 39-45 are pending and are on appeal. Claims 29-37 and 39-45 are set forth in the attached Appendix. Claims 29, 32, 34, 36, 39 and 41 are independent claims. Claims 30 and 31 depend directly from claim 29. Claim 33 depends directly from claim 32. Claim 35 depends directly from claim 34. Claim 37 depends directly from claim 36. Claim 40 depends directly from claim 39. Claims 42-45 depend directly from claim 41.

D. Status of Amendments

The Amendment filed on July 10, 2003, which has been entered, recites currently pending claims 29, 32, 34, 36 and 37. Claims 30, 31, 33, 35, 39-41 and 42-25 were originally filed in the March 13, 2003 Amendment along with a Request for Continued Examination, and have not been amended.

II. SUMMARY OF THE INVENTION AND APPLIED REFERENCES

A. Problems Addressed by the Invention

In the prior art, as evidenced, for example, by U.S. Patent 5,486,666 to Zdybel, Jr. et al., electronic documents are transferred between electronic document processing systems. As discussed in the Appellants' specification (see page 1, lines 32-36), document satchels exist which may be, for example, small, low-power, interactive devices, such as pagers or cellular phones for easily exchanging electronic documents or for requesting common operations, such as printing. Satchels fundamentally are devices for trafficking in tokens. See Appellants' specification, page 2, lines 9-13. A token is a pointer to a document, rather than a copy of a document itself. Tokens have two parts: a reference, and access information.

Conventionally, tokens are transferred electronically, which is convenient and avoids having to copy and carry paper documents. As shown in Fig. 1 of the Appellants' specification, tokens are conventionally generated electronically in a first computer system, transferred over networks to a second computer system, and stored electronically. See pages 3-4 of Appellants' specification. However, paper documents still are a primary medium for written communications and for record keeping. See page 4, lines 17-27 of Appellants' specification. Thus, because the access information portion of tokens currently make them awkward to transfer by hand copying or similar methods, a facility for transferring the tokens using paper documents would be valuable.

B. General

The invention relates to methods and systems for using paper document satchels that address the problem discussed above.

C. Description of the Invention

The claimed invention embeds tokens in paper documents to make it easier to follow references, obtain additional copies, forward copies, and keep copies without necessarily

carrying the physical paper from wherever it was encountered. The claimed invention includes paper satchels which contain embedded tokens that can be scanned by a scanner, and a scanner/token decoder that takes the scanned image data, finds and identifies the tokens in the image data, and generates a list of the identified tokens. The claimed invention can include a token selector that allows a user to choose which tokens to access, a memory in which to store selected tokens, and preferably an interpreter to perform a function, run a program, access a service, retrieve a document, or perform whatever function the user of a tokens has available, based on the contents of the tokens. These features are set forth on pages 5-7 of Appellants' specification.

Fig. 2 shows an example of how paper document satchels modify the transfer of tokens between computer systems. A token generator 210 of a first computer system (CPU 205) can still send the electronic tokens to a second CPU 245 of a second computer system. However, the first computer system can print the document tokens onto a paper document 280. The paper document then can be carried to any computer system capable of reading the tokens carried on the paper document 280. See pages 5 and 6 of Appellants' specification.

To access the information represented by the tokens, the paper document 280 is scanned by a scanner 285, which inputs the tokens to the second computer system. One or more tokens may be scanned at a time and stored and/or sent to another computer system for processing. Every document satchel has the ability to communicate the information it stores by being scanned. See page 6 of Appellants' specification.

As described with respect to Fig. 3, to read embedded tokens, the paper document 280 containing one or more document satchels is scanned, for example, by using a scanner 360. The image data generated by the scanner 360 is sent to a segmenter/token decoder 370. The segmenter/decoder 370 takes the input image data, finds and identifies the tokens in the input image data, decodes the identified tokens, and generates a list of the identified and decoded

tokens. The list can include, for example, references, documents, services, programs and the like. See page 6, lines 35-36 of Appellants' specification. The list of the decoded tokens is sent to a token selector 380, which allows a user to choose which tokens to access. Once one or more tokens are selected, the selected tokens can be stored in memory or sent to an interpreter 390. See pages 6 and 7 of Appellants' specification.

The interpreter 390 can then perform a function, run a program, access a service, retrieve a document, or perform whatever function the user of a given token has available, based on the content of the given token. See page 7 of Appellants' specification.

Two examples of encoded document satchels are shown in Figs. 4A and 4B. The encoded areas on a document may be accompanied by a human readable identifier 485, as shown in Fig. 4A. See page 8 of Appellants' specification, and Figs. 4A and 4B.

D. Advantages Over the Prior Art

As described above, the claimed invention generates a list of identified and decoded tokens, and then the list of the decoded tokens is sent to a token selector, which allows a user to select which tokens to access from the list of decoded tokens. The prior art fails to disclose a system that encodes tokens in a document that point to another document and that allows a user to select tokens from a list that includes a number of decoded tokens. Because the prior art fails to disclose this feature, it is not possible in the prior art for a user to select specific content, for example, from a list of references, documents, services and programs that is obtained from tokens that are decoded from a paper document.

III. THE ISSUES

A. Whether the Office Action's rejection of claims 29-35 under 35 USC §102(b) over U.S. Patent No. 5,905,246 to Fajkowski is in error.

B. Whether the Office Action's rejection of claims 36, 37 and 39-45 under 35 USC §103(a) over U.S. Patent No. 5,486,686 to Zdybel et al. in view of U.S. Patent No. 5,331,547 to Laszlo is in error.

IV. GROUPING OF CLAIMS

Each claim of the patent application is separately patentable, and upon issuance of a patent, will be entitled to a separate presumption of validity under 35 USC §282. For convenience of handling of this appeal, the claims are grouped as follows:

Group I: Claims 29-35

Group II: Claims 36 and 37

Group III: Claims 39-40

Group IV: Claims 41-45

Groups I, II and III do not fall together. However, because claims 36 and 37 include some of the features of claims 29-35, the claims of Group II are patentable for some of the reasons set forth for the Group I claims. The claims of Group III, i.e., claims 39-40, stand or fall together, and are separately patentable from the other claim groups. However, the claims of Group IV, i.e., claims 41-45, fall together with the Group III claims because claim 41 reads on claim 39.

V. ARGUMENT

A. Summary of Relevant Law

1. 35 USC §102

In order to be anticipatory under 35 USC §102, a prior art reference must have each and every feature set forth in the claims.

2. 35 USC §103(a)

In rejecting claims under 35 USC §103(a), it is incumbent on the examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837

F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966), and to provide a reason why one of ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish prima facie obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

It is well settled that a rejection based on 35 USC §103(a) must rest on a factual basis, which the Patent and Trademark Office has the initial duty of supplying. In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995). A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary

component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998). This evidence may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved. See Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996). However, the suggestion more often comes from the teachings of the pertinent references. See In re Rouffet, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459(Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617. However, the suggestion to combine need not be express and “may come from the prior art, as filtered through the knowledge of one skilled in the art.” Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489(Fed. Cir. 1997).

It is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using appellant's structure as a template and selecting elements from references to fill the page. The references themselves must provide some teaching whereby the appellant's combination would have been obvious. In re Gorman, 911 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir, 1991). That is, something in the prior art as a whole must suggest the desirability, and thus obviousness, of making the combination. See, In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984). He or she may not, because he or she doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

If the PTO fails to meet this burden, then the applicant is entitled to a patent. In re Glaug, 62 USPQ2d 1151 (Fed. Cir. 2002). In the present case, and as will be detailed below, Appellants respectfully submit that the Examiner has failed to meet this burden, and that the Office Action violates the substantive and procedural due process which the Office is supposed to accord Applicants via the Administrative Procedures Act. See in this regard, Dickinson v. Zurko, 527 U.S. 150, 50 USPQ2d 1930 (1999), and In re Gartside, 203 F.3d 1305, 1316, 53 USPQ2d 1769, 1776 (Fed. Cir. 2000).

B. The 35 U.S.C §102(b) Rejection of Claims 29-35 Lacks Factual Support

The Office Action alleges that col. 3, lines 51-62 of Fajkowski discloses a system for decoding tokens and using tokens encoded in a document "by means of a barcode embedded in a coupon." The bar codes are decoded by scanning them with a coupon card mechanism, which matches the number of the barcode to coupon data, and displays it on the screen of the coupon card. See col. 11, lines 46-56 and Fig. 4b of Fajkowski. However, Appellants define a "token" on page 2 of the specification, lines 10-16, as having two parts: (1) the reference; and (2) the access information. Furthermore, Appellants' specification teaches that a "token is a pointer to a document, not a copy of a document." Based on this disclosure, independent claims 29, 32 and 34 recite in the preamble, "tokens encoded in a document that point to another document." (emphasis added). Fajkowski clearly fails to disclose or suggest this feature. Accordingly, because Fajkowski does not have each and every feature set forth in claims 29-35, Fajkowski does not anticipate claims 29-35.

With respect to claims 29-35, the Office Action asserts that because the "tokens encoded in a document that point to another document," is recited in the preamble of the claims, and the preamble in claims is not necessarily given weight in determining patentability of the claims, Appellants' preamble should not be given weight. Specifically, the

Office Action cites Storage Technology vs. Level One Communications,¹ and argues that the Court of Appeals for the Federal Circuit ("Federal Circuit") in this case held that preambles are not necessarily given weight in determining the meaning of the claims. See page 2 of the Office Action.

However, the Office Action fails to specify the applicability of the facts of Storage Technology Corp. to the facts (including the claims) of this case. In fact, the Office Action provides absolutely no explanation of the applicability of Storage Technology Corp. to the facts of this application. Rather, the Office Action provides that, "[B]efore the USPTO, while the claims remain malleable, the appropriate way to change the meaning of the claims is to amend them. While the court is facing fixed claims it must interpret, applicant has had numerous opportunities to actually put the language in the body of the claims." See page 2 of the Office Action.

Appellants' respectfully point out that a leading case concerning amending claims before the Patent Office is In re Zletz, 13 USPQ2d 1320 (Fed. Cir. 1989). In Zletz, the Court held that patent applicants have the opportunity to amend their claims during prosecution in order to overcome an indefiniteness rejection. However, because there is no indefiniteness rejection of the claims pending in this application, Appellants see no need to further amend the claims at this stage in prosecution to alter the meaning of the claims.

Moreover, there is no reason for Appellants' claims to be further amended because the preamble recitation of claims 29, 32 and 34 of "tokens encoded in a document that point to another document" gives life, meaning and vitality to the claims, and thus must be given patentable weight. See, for example, in this regard, Pitney Bowes, Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305 (Fed. Cir. 1999).

¹ Appellants' believe that the Office Action meant to cite Storage Technology Corp. v. Cisco Systems, Inc., 66 USPQ2d 1545 (Fed. Cir. 2003).

In addition, in the Amendment filed on July 10, 2003, Appellants amended the preamble and the body of claim 29. The preamble was amended to change "using tokens encoded in a document" to --using tokens encoded in a document that point to another document." The body of claim was amended to change "tokens" to --such tokens--, and "decoded tokens" was amended to recite --such decoded tokens.-- The preamble of claim 32 and the preamble and the body of claim 34 were amended in a similar manner.

Claims 29 and 32 are "system" claims whereby the preamble recites "tokens encoded in a document that point to another document." Thus, in claim 29, the body expressly refers back to the tokens of the preamble by reciting a decoder that decodes a number of "such tokens" and a selector that lists a number of "such tokens." In claim 32, the body expressly refers back to the tokens of the preamble by reciting a selector means for selecting one or more of the user-selectable tokens. Claims 30-31 depend from claim 29 and contain the positively recited features of claim 29. Claim 33 depends from claim 32 and contains the positively recited features of claim 32. Claim 34 is a method claim in which the preamble recites "using user-selectable tokens encoded in a document that point to another document" and in which the body of the claim expressly refers back to the tokens of the preamble by reciting decoding at least one "such user selectable token." Claim 35 depends from claim 34 and contains all the features of claim 34.

The Federal Circuit held in Eaton Corp. v. Rockwell International Corp., 66 USPQ2d 1271, 1276 (Fed. Cir. 2003), citing Pitney Bowes, Inc. v. Hewlett-Packard Co., 51 USPQ2d 1161, 1165 (Fed. Cir. 1999), that "a claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use *both* the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects." In claims 29-35 of this application, the claim preambles define tokens as tokens that point to another document, and the claim bodies

provide the same definition by explicitly referring to "such tokens" or to "the user-selectable tokens." Appellants respectfully submit that, as in Eaton, claims 29-35 of this application use both the preamble and the body to define the subject matter of the claimed invention.

The Federal Circuit also held in In re Cruciferous Sprout Litigation, 64 USPQ2d 1202, 1204 (Fed. Cir. 2002), that clear reliance on the preamble during the prosecution to distinguish the claims from the prior art may indicate that the preamble is a claim limitation because the preamble is used to define the claimed invention. The Court held in Cruciferous that both the specification and the prosecution history indicate that a preamble phrase helped to define the claimed invention and, therefore, was a limitation of the patent. In this application, the prosecution history includes Appellants' assertion that the preamble is a positively recited feature of the claims. Moreover, the specification itself supports this conclusion. In this regard, the statement on page 1 of the specification (under "Field of the Invention") clearly supports the conclusion that the preamble is a positively recited feature of claims 29-35 because Appellants' specification states that ". . . the invention is directed to encoding areas of a paper document so that those areas may be scanned into a processing system in order to access additional documents, information, etc." (emphasis added).

Although the Office Action appears to cite Storage Technology Corp., Appellants submit that this case is entirely inapposite to the facts of this application. In Storage Technology Corp., the district court based its interpretation in part on the presence of the phrase "policy caching method" or "policy cache" in the preamble of every independent claim of the '040 patent. The Federal Circuit held that "[w]hether to treat a preamble as a claim limitation is determined on the facts of each case in light of the claim as a whole and the invention described in the patent," citing Catalina Mkts. Int'l Inc. v. Coolsavings.com Inc., 289 F.3d 801, 62 USPQ2d 1781, 1784 (Fed. Cir. 2002). Based on this decision, the Federal Circuit determined that "the written description consistently uses the terms 'policy caching

method' and 'policy cache' to refer to the invention as a whole." (emphasis added). Similarly, the term "policy caching method" or "policy cache" in the preamble of each claim was found to serve "as a convenient label for the invention as a whole." (emphasis added). Thus, the preamble terms were held not to limit claim scope and simply refer to the invention set forth in the body of the claim. However, the facts present in Storage Technology Corp. are not present in this application because the preambles of claims 29, 32 and 34 include limitations that the limitations in the body of the claims rely upon. Furthermore, the limitations in the body of the claims derive antecedent basis from the preamble.

In Eaton, the Federal Circuit held that the preamble may act as a necessary component of the claims' invention when limitations in the body of the claim rely upon and derive antecedent basis from the preamble. Eaton, 66 USPQ2d at 1276. The Office Action fails to address this aspect of Eaton and also fails to apply any facts of Storage Technology Corp. to this application. In claims 29 and 34 of this application, the phrase "such tokens" in the body refers back to the "tokens encoded in a document that point to another document" recited in the preamble of the claims. Thus, the preambles of claims 29 and 34 limit the meaning of "such tokens" in the bodies. In claim 32, the phrase "the user-selectable tokens" in the body refer back to the "user-selectable tokens encoded in a document that point to another document" recited in the preamble. Thus, the preamble of claim 32 limits the meaning of "the user-selectable tokens" recited in the body.

Based on the Federal Circuit's decision in Eaton, the preambles of claims 29-35 should be given patentable weight. Furthermore, because Fajkowski clearly fails to disclose or suggest "tokens encoded in a document that point to another document," the rejection of claims 29-35 under 35 U.S.C. §102(b) is improper and should be withdrawn.

C. The 35 U.S.C §103(a) Rejection of Claims 36, 37 and 39-45 Lacks Factual Support

The Office Action also rejects claims 36, 37 and 39-45 under 35 U.S.C. §103(a) over U.S. Patent No. 5,486,686 to Zdybel in view of U.S. Patent No. 5,331,547 to Laszlo.

Independent claim 36 recites a system for processing a paper document including "a token selector that allows a user to select which decoded tokens to access from a list of decoded tokens." (emphasis added).

Independent claim 39 recites method for producing and processing a paper document including "generating at least one user-selectable token relating to at least one other document, the other document being an electronic document, the at least one user-selectable token usable to link the other document to the paper document." (emphasis added).

Independent claim 41 recites a method of permitting use of a paper document containing at least one encoded user-selectable token including "providing the at least one user selectable token with an accompanying human readable identifier."

The Office Action admits that Zdybel does not disclose "a token relating to at least one other document, that document being electronic," See Office Action, page 5, lines 1-2. Thus, the Office Action relies on Laszlo to compensate for deficiencies in Zdybel by alleging that Laszlo teaches using "a token to link a hardcopy document to a related electronic document. See col. 4, lines 31-34, lines 66-68 and col. 5, lines 1-4 of Laszlo.

Nowhere in Zdybel or Laszlo is it disclosed or suggested that a user can select which decoded tokens to access from a list of decoded tokens. Instead, Zdybel discloses that "glyph encodings" (encodings representing distinctive markings having at least two distinguishable, machine readable states -viz., a true ("1") state and a false ("0") state) are merged into an electronic documents description file for the electronic document to cause the glyphs to be printed on the hardcopy output document at one or more location. See col. 8, lines 44-50 of

Zdybel. However, the glyphs are not tokens having two parts (i.e., the reference and the access information). Furthermore, the glyphs that are printed on the hardcopy output document in Zdybel are not decoded, and instead are glyph encodings as defined above. In fact, Appellant distinguishes between embedding glyphs in a printed document and embedding tokens in a paper document. See page 5, lines 28-34 of Appellants' specification.

Laszlo does not compensate for deficiencies in Zdybel because Laszlo prints hard copy documents with relevant bar code symbols in place. See col. 4, lines 31-37 of Laszlo. However, the printed bar code symbols are not "tokens" as defined by the claimed invention. For example, Appellant distinguishes between traditional bar codes that are printed marks placed on a page and embedded tokens in paper documents. See page 5, lines 24-27 of Appellants' specification. Accordingly both Zdybel and Laszlo fail to disclose the features of claims 36, 37 and 39-45.

As discussed above, a rejection based on 35 U.S.C. §103(a) must be established by the examiner based on a factual basis and include a showing of a suggestion, teaching or *motivation* to combine the prior art references. The Office Action on page 2 asserts, with respect to the alleged teaching, suggestion or motivation to combine the references, that "[i]n this case, the knowledge would be generally available to one of ordinary skill in the art." (emphasis added). See Office Action, page 2, paragraph 1, lines 18-19.

However, the Office Action provides absolutely no evidence of this knowledge. The Office Action instead makes a "broad conclusory statement" about the teachings of Zdybel and Laszlo because no evidence of the alleged knowledge is provided.

Furthermore, the Office Action provides absolutely no motivation to combine the applied references. The Office Action implies that because two references use bar code readers to obtain information from hardcopy documents, the references are in the same class. However, this statement is not clear and particular evidence of a motivation to combine their

teachings. Simply classifying patents in the same class cannot be a basis for combining such patents under 35 U.S.C. §103(a).

The Office Action is completely silent as to how the teachings of Zdybel are to be modified in view of the teachings of Laszlo. Instead, the Office Action simply provides speculation as to what would happen if the two references were combined, to wit: "[T]his modification basically expands the range of links for Zdybel's tokens." This statement falls well short of providing evidence of motivation to combine the references because nothing in the Office Action demonstrates how a disclosed feature flows from either the prior art references themselves, the knowledge of one skilled in the art or a nature of the problem to be solved. On the contrary, the statement in the Office Action is only a speculative statement of what might happen if these two references are somehow combined.

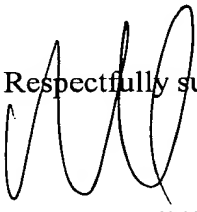
As provided above, the factual basis of a rejection under 35 U.S.C. §103(a) must be interpreted without hindsight reconstruction of the invention from the prior art. However, the Office Action does not supply the factual basis for the rejection being advanced. On the contrary, the alleged reasoning in the Office Action for combining Zdybel and Laszlo is based on speculation and/or on improper hindsight reconstruction of Appellants' claimed invention based solely on Appellants' own disclosure as a template because the Office Action does not use the references themselves to provide some teaching whereby the combination would render the claimed invention obvious.

Accordingly, because the Office Action fails to make out a prima facie case of obviousness of the subject matter of claims 36, 37 and 39-45, the rejection under 35 U.S.C. §103(a) is improper and should be withdrawn. Appellants respectfully submit that claims 36, 37 and 39-45 are allowable and that the application is in condition for allowance.

VI. CONCLUSION

For at least the reasons outlined above, Fajkowski does not anticipate the subject matter of claims 29-35. Moreover, Zdybel and Laszlo do not render obvious the subject matter of claims 36, 37 and 39-45 under 35 USC §103(a). Thus, claims 29-37 and 39-45 define subject matter that is patentable over the applied references.

The Honorable Board is requested to reverse the rejections set forth in the Final Rejection and return the application to the Examiner to pass this case to issue.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Richard S. Elias
Registration No. 48,806

JAO:RSE

Enclosure:
Appendix

Date: May 24, 2004

Oliff & Berridge, PLC
P.O. Box 19928
Alexandria, VA 22320
Telephone: (703) 836-6400

APPENDIX OF CLAIMS

29. A system for decoding and using tokens encoded in a document that point to another document, comprising:

a decoder that decodes a number of such tokens encoded in a document; and

a selector that lists a number of such decoded tokens.

30. The system of claim 29, wherein the selector allows a user to select one or more of the decoded tokens from the list of decoded tokens.

31. The system of claim 29, wherein the document is a paper document.

32. A system for decoding and using user-selectable tokens encoded in a document that point to another document, comprising:

selector means for selecting one or more of the user-selectable tokens from a list of user-selectable decoded tokens that have been decoded from the document.

33. The system of claim 32, wherein the document is a paper document.

34. A method for decoding and using user-selectable tokens encoded in a document that point to another document, comprising:

decoding at least one such user selectable token that has been encoded into a document; and

creating a list of the user-selectable tokens that have been decoded.

35. The method of claim 34, further comprising selecting one or more tokens from the list of the decoded user-selectable tokens.

36. A system for processing a paper document, comprising:

a scanner that reads tokens that have been embedded in the paper document and that point to another document;

a segment token decoder that receives image data from the scanner and identifies and decodes the tokens; and

a token selector that allows a user to select which decoded tokens to access from a list of decoded tokens.

37. The system of claim 36, further comprising a list generator to generate the list of decoded tokens.

39. A method for producing and processing a paper document, comprising:
generating at least one user-selectable token relating to at least one other document, the other document being an electronic document, the at least one user-selectable token usable to link the other document to the paper document;

encoding the at least one user selectable token and an accompanying human readable identifier; and

printing the at least one encoded token and accompanying human readable identifier onto the paper document.

40. The method of claim 39, wherein the human readable identifier is at least one of an icon, descriptive text and a logo.

41. A method of permitting use of a paper document containing at least one encoded user-selectable token, comprising:

providing the at least one user selectable token with an accompanying human readable identifier.

42. The method of claim 41, wherein the encoded user-selectable token relates to at least one other document, the other document being an electronic document, the at least one user-selectable token usable to link the other document to the paper document.

43. The method of claim 41, wherein the encoded user-selectable token relates to information which simulates an environment described in the paper document.

44. The method of claim 41, further comprising:
printing the at least one encoded tokens and accompanying human readable
identifier onto the paper document.
45. The method of claim 41, further comprising scanning the encoded at least one
user-selectable token.